FILED

IN THE

Supreme Court of the United States

—— TERM, 1973

No. 73-1655

PARKER SWEEPER COMPANY,

Petitioner,

v.

THE E. T. RUGG COMPANY,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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Petitioner PARKER SWEEPER COMPANY prays that a writ of certiorari be issued to review that part of the judgment of the United States Court of Appeals for the Sixth Circuit entered in the case of *PARKER SWEEPER CO.* v. *E. T. RUGG CO.* on February 27, 1973 that reversed the judgment of the United States District Court for the Southern District of Ohio, Eastern Division, holding Petitioner's United States Patents Nos. 3,035,294 and Des. 194,051 valid.

OPINIONS BELOW

The as yet unreported opinion of the District Judge is appended hereto at pages 1a-15a, as Appendix A. The

opinion of the Court of Appeals for the Sixth Circuit, __ F.2d __, 177 USPQ 161 (6th Cir. 1973), is appended hereto at pages 16a-28a, as Appendix B.

JURISDICTION

The judgment of the Court of Appeals was entered on February 27, 1973; Petitioner's Petition for Rehearing, characterized by the clerk of the Court of Appeals as "motions for rehearing and rehearing in banc" was denied on April 16, 1973. The jurisdiction of this Court is invoked under Section 1254(1) of Title 28, United States Code, June 25, 1948, c. 646, 62 Stat. 928.

QUESTION PRESENTED

In view of the statutory presumption of validity (35 U.S.C. 282) which attaches to an issued United States patent, should a Court of Appeals substitute its opinion respecting obviousness (35 U.S.C. 103) for that of the District Judge when the District Judge has arrived at his opinion by applying the test for obviousness laid down by the Supreme Court in *Graham* v. *John Deere Co.*, infra, to the factual evidence before him, which evidence included the testimony of expert witnesses, and as to which evidence he made careful findings of fact, all of which findings were fully accepted by the Court of Appeals?

STATUTES INVOLVED

The specific patent statutes involved are Title 35, Patents, Act of July 19, 1952, c. 950, sec. 1, 66 Stat. 792, especially 35 U.S.C., Sections 101 (66 Stat. 797), 102 (66 Stat. 797 and, as amended July 28, 1972, 86 Stat. 502), 103 (66 Stat. 798) and 282 (66 Stat. 812 and, as amended July 24, 1965, 79 Stat. 261), with emphasis on sections 103 and 282. All of these statutes are set forth at p. 29a et seq. as Appendix C.

STATEMENT OF CASE

This case is one for patent infringement in which the validity of the patents was challenged. Federal jurisdiction in the District Court, the court of first instance, as to the parties involved and the subject matter, was in accordance with Title 28 U.S.C. 1338(a) (62 Stat. 931 and, as amended Dec. 24, 1970, 84 Stat. 1559) and 1400(b) (62 Stat. 936) and under the patent laws of the United States, Title 35, U.S.C., sections 101, 102, 103 and 282 (also 271, 283, 284 and 285), as set forth in Appendix C at p. 29a et seq.

Petitioner, PARKER SWEEPER COMPANY, is an Ohio corporation and the owner of the patents in suit, namely, United States Patents Nos. 3,035,294 and Des. 194,051 (Exhibits 5 and 6—App. pp. 6 and 10)* relating to the structure and appearance, respectively, of a trailing dumpable lawn sweeper design to be pulled behind a home garden tractor to pick up leaves and debris and later dump them on a trash pile (p. 2a).*

The lawn sweeper covered by the patents in suit comprises a cart frame having a pair of spaced upright side sections with axle means at the front and rear, such axle means supporting ground engaging wheels; and a rotary work element carried by the front of the frame and arranged to sweep debris into an open top and open front debris receptacle which is pivotally mounted between the frame sections; the pivotal support for the receptacle being so arranged that it is forward of the receptacle center of gravity so that when an operator, sitting on the tractor seat, pulls the cord attached to the top of the receptacle, the receptacle will dump the debris therefrom

* "Exhibits" refer to those introduced in the District Court; "App." refers to the Appendix filed in the Court of Appeals; "Record" refers to items introduced in the District Court but not reproduced in the Appendix; and "p. —a" refers to pages of those Appendixes appended hereto.

and will automatically return to its debris-receiving position when the operator releases the cord (p. 2a).

Respondent, THE E. T. RUGG COMPANY, manufactured for Sears, Roebuck & Company a trailing dumpable lawn sweeper which appeared to both the District Judge and to the Court of Appeals to have been deliberately copied from Petitioner's commercially successful product (p. 17a).

The Parker sweeper of the patents in suit was developed in about 1960 (App. p. 108). There were no other trailing dumpable lawn sweepers available on the market when Petitioner Parker introduced its sweeper, which embodied the teachings of the patents in question, to the market in 1960 (p. 4a). (Respondent did not enter this market until 1966—pp. 4a and 18a.)

The problem of lawn debris removal had existed for many years and prior to 1960 other arrangements were tried; first, an end-over dumpable sweeper; second, a sweeper with a fixed basket but having a removable bailing liner; third, a sweeper with a removable basket; fourth, a towable sweeper with a bailing liner (two persons were needed to handle it); and fifth, a towable sweeper with a basket pivoted on trunnions for side dumping (one person could handle it but he had to get off the tractor); these arrangements, however, were not suitable for the home market—more was needed (all at App. pp. 101-103 and p. 17a).

Petitioner's patented sweeper when introduced in 1960 was a prompt and substantial success as noted by both the District Judge and the Court of Appeals (pp. 4a and 18a).

Respondent Rugg challenged the validity of the patents in suit on the basis of nine (App. pp. 207-208) patents (Exhibits A-4, 6, 10, 11, 15, 22, 23, 25 and 27, copies reproduced at App. pp. 32, 36, 40, 45, 54, 69, 76, and 85).

All of these nine patents relied upon by Respondent as indicating the state of the prior art were classified by the United States Patent Office in the same classes and subclasses as were the patents cited by the Patent Office Examiner during the prosecution of the application of the patents in question (p. 8a) and were undoubtedly considered by the Examiner during his search (p. 8a). These patents were selected by Respondent from an original list of 28 patents, counsel for Respondent stating that those patents not selected, which included those actually cited by the Examiner, were no more important and only cumulative (App. pp. 207-208).

Five of the nine patents constituting the prior art relied upon by Respondent as being in anticipation of the patents in suit issued in the period 1891 to 1902; the four most recent issued in the period 1948 to 1956 (p. 6a).

The Patent Office considered the inventions of the patents in suit from the standpoint of obviousness; indeed, it initially rejected certain claims "as being obviously fully met" (Record, Exhibit 3, p. 15, Office Action Feb. 25, 1960 paragraphs 3 and 4), a rejection which it eventually withdrew as evidenced by the allowance of the patents.

The District Judge heard expert testimony concerning the nine prior art patents relied upon by Respondent; this testimony included Respondent Rugg's expert (App. pp. 181-199 and 217-225) and Petitioner Parker's expert (App. pp. 234-250). Additionally, the uncontroverted testimony of Petitioner's expert is that it would not have been obvious to him to proceed from these prior art patents to "this unique device, this sweeper" of the patents in suit (App. pp. 238, 240-241 and 246-247).

Based on the foregoing testimony, which is referred to by the District Judge (see, for example, p. 7a), the District Judge made, to use the language of the Court of Appeals, "careful findings of fact" (p. 18a), concerning

all of these prior art patents, see especially Findings of Fact 17 (p. 5a et seq.), in which dissimilarities were noted between this prior art and the patents in suit.

The District Judge also made the following pertinent findings of fact:

(8) There were no other trailing dumpable lawn sweepers available when Petitioner Parker introduced its sweepers, which embodied the teachings of the patents in question, to the market in 1960 (p. 4a).

(9) Commercially the sweepers were a prompt and substantial success (p. 4a).

(17a) The four most recent patents (A-22, A-23, A-25 and A-27) each concerned manually pushed lawn sweepers with fixed debris receptacles; they suggested only the need for a better way to remove lawn debris (p. 6a). (These four patents issued in the period 1948-1955.)

(17b) The five old patents relate to horse-drawn street sweepers (A-4 and A-10), manually pushed street sweepers (A-6 and A-11), and an attachment for a lawn mower (p. 6a et seq.). (These five patents issued in the period 1891-1902.) These five patents are described, with reference to expert testimony, and in each case significant dissimilarities are found with respect to the sweeper of the patents in suit (p. 6a et seq.).

(18) The nine patents relied upon by Respondent Rugg were such as to have been considered by the Patent Office (p. 8a; see also p. 6a).

The District Judge concluded that the patents in suit were valid (pp. 8a and 11a).

In its opinion, the Court of Appeals accepted all of the following:

(a) The "careful" findings of the District Judge—they "certainly" are *not* "clearly erroneous" (p. 18a).

(b) The facts that the Parker sweeper met the test of utility fully and it passed the test of novelty (p. 18a).

(c) The District Judge's statement of the law applicable to a determination of obviousness (p. 18a).

(d) The applicability of the secondary considerations, e.g., a long felt want of which Respondent Rugg as a manufacturer of lawn mowers would have been at least cognizant of but which, despite the existence of the 19th century sweepers, was not filled until Petitioner Parker developed the sweeper of the patent in suit in 1960 (p. 20a), and the "skyrocketed" sales which resulted, the best evidence as to commercial success (pp. 18a and 20a).

(e) The presumption of validity (p. 20a).

The Court of Appeals, in reversing the District Judge, concluded, as a matter of law, that the Parker sweeper patent was invalid because the record demonstrated a failure to meet the nonobviousness test of 35 U.S.C. 103 (p. 25a).

REASONS FOR GRANTING CERTIORARI

I. The Question Presented Is of Importance in the Interpretation of the Patent Laws.

This Supreme Court, in the exercise of its sound judicial discretion, should settle the question of how much weight is to be given the statutory presumption of validity, particularly when both the Patent Office, in considering the obviousness or nonobviousness of the invention in the first instance, and the District Judge in considering the obviousness or nonobviousness of the invention in the second instance, based on evidence adduced at trial, conclude that the subject matter of the invention as a whole would not have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

The Patent Laws set forth three fundamental criteria for the granting of a patent on a machine: (a) the machine must be useful, 35 U.S.C. 101 (p. 29a); (b) the machine

must be novel, 35 U.S.C. 102 (p. 29a); and (c) the machine must not have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains, 35 U.S.C. 103 (p. 30a).

The Court of Appeals below stated: "We agree with the District Court that Parker's lawn sweeper passed the first two tests of novelty and utility. It still must pass the test of Sec. 103 which provides . . .".

In *Graham* v. *John Deere Co.*, 383 U.S. 1, 17-18 (1966), the Supreme Court established the test for obviousness:

> "[11] While the ultimate question of patent validity is one of law. A. & P. Tea Co. v. Supermarket Corp., supra, 340 US at 155, 95 L ed at 168, the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances * surrounding the origin of the subject
>
> * [383 US 18]
>
> matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy. See Note, Subtests of "Nonobviousness": A Nontechnical Approach to Patent Validity, 112 U Pa L Rev 1169 (1964)."

The District Judge did indeed follow this test for determining "obviousness" (p. 9a) and the Court of Appeals specifically recognized this fact (pp. 18a to 20a):

> "As we have indicated, we also agree with the District Judge that the Parker sweeper met the test of

utility fully and had sufficient differences in its method of combination of previously known elements to pass the test of novelty.

"Nor do we find any fault with the District Judge's statement of the law applicable to a determination of 'obviousness':

> 'A three-step test has been established by the Sixth Circuit in determining the question of what constitutes "obviousness." *Westwood Chemical, Inc.* v. *Owens-Corning Fiberglas Corp.*, 445 F.2d 911 [6th Cir. 1971]. The first step is a factual determination of the prior art; second, a factual determination of what, if any, improvement the patentee has made over the prior art; and third, a legal question of whether the improvement would have been obvious to one skilled in the art. Additionally, the Supreme Court in *Graham* v. *John Deere Company*, 383 U.S. 1 (1965), has indicated secondary considerations such as commercial success, long felt but unsolved needs, failures of others, etc., as relevant indicia of obviousness or non-obviousness. Such secondary considerations might also be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.'

"The rationale of the District Judge and of the appellees in dealing with the obviousness test is set forth as follows in the last sentence of finding 17:

> 'The prior art as set forth in the above patents does not appear to be, both collectively and individually, the subject matter therein such as would make the patent in question obvious to a person having ordinary skill in the art.'

"As we have indicated above, this sentence appears to be the ultimate conclusion of law which the District Judge subsequently supported with this reasoning under the heading of Conclusions of Law:

> 'The state of the prior art has been indicated by the parties through the introduction in evi-

dence of nine patents. They fall naturally into two categories; those of modern origin concerned exclusively with a non-dumpable manually pushed sweeper, and those of the nineteenth century addressed primarily to the unique problems of that era. The teachings of the prior art do include elements of the patent in question. It would be difficult indeed to imagine a mechanical device for the removal of debris and the deposit of such debris in a receptacle for later emptying that would not follow certain basic physical principles. The combination, however, of such established elements with a useful and novel result does create a patentable device, even though the elements of the combination are old and well known.'

"The District Judge and appellants also rely strongly upon secondary considerations and the presumption of validity of a patent once issued:

'The secondary considerations referred to in Deere reinforce the non-obviousness of plaintiff's patent. The move to suburbia following World War II created the enormous and profitable home lawn and garden industry. The riding tractor made grass cutting chores substantially easier. There was needed only some device to remove the grass clippings after cutting during the summer and fallen leaves in the autumn. These tasks continued to be manual, time-consuming, and unpleasant. Defendant as a manufacturer of lawn mowers would have been at least cognizant of this problem. The fact is, however, that neither defendant nor anyone else solved this problem until plaintiff marketed its product and the depth of the felt need was immediately apparent. An increase in sales in excess of 6,000% is probably the best evidence available as to the commercial success of this invention.

'The law is clear that a patent once issued is presumed valid, (35 U.S.C. § 282) and that a

> heavy burden of proof rests upon the party attempting to prove invalidity. *Westwood Chemical, Inc.* v. *Owens-Corning, supra* [445 F.2d 911 (6th Cir. 1971)].'
>
> "Accepting, as we do, the findings of fact of the trial judge and the applicability of both the secondary considerations and the presumption just referred to, we are still unable to agree that the resulting product was "nonobvious" within the meaning of the constitutional and statutory scheme."

It is thus apparent that the Court of Appeals gave lip service only to the statutory presumption of patent validity. This, of course, is the very question this Supreme Court is now being asked to determine, that is: Where the District Judge has meticulously followed the mandates of the Supreme Court in considering evidence on the question of "obviousness" and, in the light of this evidence has made findings of fact which are fully accepted by the Court of Appeals, should the Court of Appeals thereafter substitute its opinion on the "ultimate question of law" for that of the District Judge when the patent is further bolstered by the statutory presumption of validity? Clearly the answer should be no.

This Supreme Court, therefore, is by this Petition being asked to lay down guide lines as to the statutory presumption of patent validity, 35 U.S.C. 282 (p. 31a), and its relationship to the test for obviousness, 35 U.S.C. 103. No such Supreme Court guide lines presently exist.

II. The Decision Below on the Question of Obviousness Was Inconsistent with Fundamental Principles Applied by the Sixth Circuit Itself.

In the court below the Court of Appeals, after accepting the District Judge's findings of fact, which findings included a detailed analysis of the nine prior art patents relied upon by Respondent as in anticipation of the patents in suit (pp. 5a to 7a), then made its own analysis of

these patents and apparently found enough similarities to enable it to conclude that while:

> ". . . no one of the prior art patents shows all of the features of the Parker sweeper in the same combination.
>
> "What we do hold is that the state of the art included all of these patents and that a skillful mechanic setting out to build a towable dumpable lawn sweeper to be used in connection with a lawn mower tractor in the early 1960's could accomplish his mission without adding any 'invention' to the art." (p. 24a.)

The Court of Appeals, however, having fully accepted the District Judge's findings as to the disclosures of these prior art patents, had no cause to consider these documents further because, not having found the District Judge's findings with respect thereto clearly erroneous, they were binding on it, *H. K. Porter Company* v. *Goodyear Tire & Rubber Company*, 437 F.2d 244, 246 (6th Cir. 1971), cert. den. 404 U.S. 885 (1971) which held that the clearly erroneous rule applies to findings based solely on documentary evidence.

The Sixth Circuit Court of Appeals has applied the test for obviousness laid down by the Supreme Court in *Graham* v. *John Deere Co.*, supra, a number of times, e.g., *Porter* v. *Goodyear*, supra; and *Kolene Corporation* v. *Motor City Metal Treating, Inc.*, 440 F.2d 77, 81 (6th Cir. 1971), cert. den. 404 U.S. 886 (1971). Having properly applied this test, and having made factual determinations, the District Judge may then resolve the legal question of whether the inventions were obvious to one skilled in the art, *Westwood Chemical, Inc.* v. *Owens-Corning Fiberglas Corp.*, 445 F.2d 911, 917 (6th Cir. 1971), cert. den. 405 U.S. 917 (1972). Thus, having accepted all of the District Judge's findings, including those relating to the prior art, which were the bases for his holding of nonobviousness, (and also those relating to the secondary considerations

referred to in *Graham* v. *John Deere Co.* — p. 20a), the statutory presumption of validity should have prevailed; this statutory presumption of validity should not be ignored nor passed over lightly.

III. The Decision Below on the Question of the Statutory Presumption of Validity Was Inconsistent with Fundamental Principles Applied by the Sixth Circuit Itself.

The Sixth Circuit Court of Appeals has, in the past, made it abundantly clear that there must be "evidence" to overcome the statutory presumption of validity; see, for example: *United States Gypsum Co.* v. *Dale Industries Inc.*, 383 F.2d 497 (6th Cir. 1967); *FMC Corporation* v. *F. E. Myers & Bro. Co.*, 384 F.2d 4 (6th Cir. 1967), cert. den. 390 U.S. 988 (1968); and *Panduit Corporation* v. *Stahlin Bros. Fibre Works, Inc.*, 430 F.2d 221 (6th Cir. 1970), cert. den. 401 U.S. 939 (1971).

In *U. S. Gypsum* v. *Dale*, supra, at p. 502, the Court of Appeals noted that it is up to a defendant to produce "sufficient evidence" to overbear the presumption of validity. It is "the evidence presented" which must work to overcome the presumption of validity, *FMC Corporation* v. *F. E. Myers Co.*, supra, at p. 9. It is up to a defendant to rebut the presumption of validity, *Panduit Corporation* v. *Stahlin Bros. Inc.*, supra, at p. 225.

All of the evidence and testimony in the instant case were considered by the District Judge and made the subject of findings of fact which were fully accepted by the Court of Appeals. These findings, these "factual determinations", properly enabled the District Judge to resolve the legal question of obviousness. The District Judge's findings of fact as to the teachings of the prior art patents are binding on the Court of Appeals unless clearly erroneous, *Westwood Chemical* v. *Owens-Corning*, supra, at pp. 915 and 917. And, as also noted in *Westwood Chemical* v. *Owens-Corning*, supra, at p. 914, "The law is clear that a patent

once issued is presumed valid, 35 U.S.C. 282, and that a heavy burden of proof rests on the party attempting to prove invalidity."

The Court of Appeals, in the instant case, did not apply these principles it so well laid out in its previous decisions as noted herein. In this it was in error.

CONCLUSION

The statutory presumption of validity must be recognized and given vitality. It attaches after the Patent Office considers many factors, including the question of obviousness, and resolves such factors in applicant's favor. A heavy burden rests on one who would upset it. Evidence must be produced and such is considered by the District Court. Findings of fact, based on such evidence and on which the legal question of obviousness is resolved, are binding on the Court of Appeals unless clearly erroneous. This includes those findings describing the effect of prior art patents on the question of obviousness, findings made after expert testimony thereon was heard. All of these principles have been recognized in earlier Sixth Circuit Court of Appeals decisions.

In departing from the principles laid down by the Supreme Court and even applied by the Sixth Circuit Court of Appeals in its earlier decisions, the Court of Appeals below erred; Petitioner clearly was entitled to have the District Judge's decision holding the patents valid, affirmed.

This petition for a writ of certiorari should be granted.

Respectfully submitted,

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